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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/542,545

07/18/2005

Yousuke Nishimura

Q88808

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23373 7590 04/23/2007
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

HU, HENRY S

ART UNIT

PAPER NUMBER

1713

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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31 DAYS

04/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/542,545

Applicant(s)

NISHIMURA ET AL.

Examiner

Henry S. Hu

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Pre-Amendment of July 18, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2 pages.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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1. USPTO has received **Pre-Amendment** and **two IDS** (1 page each) filed on July 18, 2005, July 18, 2005 and March 29, 2007 respectively. **Claims 1, 3-6 and 9 were amended**, while no claim was cancelled or added. To be specific, the claim amendments were only to remove improper multiple dependency on dependent Claims 3-6 and 9 as well as to correct a typographical error on parent Claim 1. **Claims 1-9 with two independent claims (Claim 1 and Claim 7) are pending now.** An action follows.

DETAILED ACTION

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1, this is based on the preliminary search done by the examiner.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted as following:

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I. **Claims 1-6**, drawn to **a process for preparing a fluorine-containing polymer**, which is a batch copolymerization process conducted under conditions of reduced temperature and reduced pressure following Peng-Robinson formula.

II. **Claims 7-9**, drawn to **a peroxide vulcanizable fluorine-containing elastomer** comprising: (A) 20 to 90 % by mole of vinylidene fluoride and (B) 10 to 80 % by mole of hexafluoro-propylene. The number average molecular weight, VDF branch ratio and iodine content are as specified.

3. Where the group of inventions is claimed in one and the same international application, the requirement for unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “**special technical features**” shall mean those technical features that define a contribution which each of the claimed inventions considered as a whole, **makes over the prior art**. The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, although they share the special technical feature, this special technical feature does not define a contribution over the prior art for the following reasons:

4. In view of international search report for **PCT/JP2004/000519 (WO 2004/065436 A1)** and the references or articles cited in **two IDS** filed so far by the Applicants, **Claims 1-9** is either obvious or anticipated by following: **JP 05-222130 A to Carlson, WO 00/47641 A1 to**

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Saito et al., WO 01/34666 A1 to Tokuno et al., and WO 03/42259 A1 to Otoi et al. (all four are cited as X reference) as well as **US 6,509,429 B1 (or its equivalent WO 00/01741) to Kitaichi et al.**, each individually or in combination. In summary, these methods have no common features in the preparation as well as its application since **they are related to a specified method or a specified product.** The scope of the claims, i.e., the metes and boundaries are distinct. Accordingly, the special technical feature linking the inventions does not provide a contribution over the prior art, and no single general inventive concept exists. Therefore the restriction is appropriate

5. **Group I is found to be structurally distinct from Group II.** To be more specific, fluorinated elastomer in **Group II** may be prepared by different chemistry other than the process of **Group II**, which is achieved specifically by applying a specified batch copolymerization process conducted under conditions of reduced temperature and reduced pressure following Peng-Robinson formula. The fluorinated elastomeric polymer in Group II is limited to copolymer of VDF/HFP with ratio as specified, while the process Group I is to prepare fluorinated elastomeric polymer in a polymerization condition following Peng-Robinson formula. Process of Group I can be used to prepare fluorinated elastomeric polymer other than copolymer of VDF/HFP from Group II.

6. Because these inventions are distinct for the reasons given above shown as different subject matters and the search required for each group is not required for other groups have

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acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. A telephone call was made to **Abraham J. Rosner (reg. # 33,276, tel: 202 293-7060)** on the date of October 20, 2006 to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Conclusion

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10. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Dr. Henry S. Hu whose telephone number is (571) 272-1103**. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300 for all regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Henry S. Hu

Patent Examiner, Art Unit 1713, USPTO

April 17, 2007



DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700